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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,225	08/26/2003	Minoru Koyama	116742	1905

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/647,225	Applicant(s) KOYAMA, MINORU	
	Examiner Alain L. Bashore	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 5-13 in the reply filed on 10-13-06 is acknowledged. The traversal is on the ground(s) that the search and examination could be made without serious burden.

a) This is found persuasive regarding claims 5-8. Claims 5-8 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. Because claims 5-8 were previously withdrawn from consideration under 37 CFR 1.142 and have now been rejoined, **the restriction requirement as set forth in the Office action mailed on 9-20-06 is hereby withdrawn regarding claims 5-8 as separate and distinct from claims 1-4.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented (i.e. claims 5-8) in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

b) This is not found persuasive for claims 9-13 because claims 9-13 are pertaining to apparatus claims which have different considerations in the art as set forth in the restriction requirement of 9-20-06.

2. The requirement regarding claims 9-13 is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102 and 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (JP-2001-180007).

Suzuki appears to disclose a film forming method comprising preliminarily discharging liquid droplets from head, relatively moving the heads and a work to discharge the liquid droplets onto a surface of a wok from the heads, and the preliminary discharge of the liquid droplets being carried out while the heads and/or

work are moved, further being carried out during acceleration of the heads and/or work up to a predetermined speed (see abstract).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (JP-2001-180007) in view of Hiroshi et al (JP-2002-067346).

Suzuki discloses what is described in the 35 USC 102 rejection above. Suzuki discloses what could be described broadly as a liquid droplet reception area, but Suzuki does not disclose the preliminary discharge of the liquid droplets being carried out in a liquid droplet reception area, a part of which is formed by the work.

Hiroshi et al discloses a liquid reception area, a part of which is formed by the work (described as "annulment regions; 70a-70c; see abstract).

It would have been obvious to one with ordinary skill in the art to include a liquid reception area, a part of which is formed by the work because Hiroshi teaches certain forming of multiple images requiring preliminary discharge of liquid droplets.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (JP-2001-180007) in view of Fujii et al.

Suzuki discloses what is described in the 35 USC 102 rejection above. Suzuki does not disclose further comprising a vibrating step of, after liquid droplet

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discharge step, vibrating liquid within the heads to a extent that the liquid is not discharged from the heads.

Fujii et al discloses a vibrating step of, after liquid droplet discharge step, vibrating liquid within the heads to a extent that the liquid is not discharged from the heads (see abstract).

It would have been obvious to one with ordinary skill in the art to include a vibrating step of, after liquid droplet discharge step, vibrating liquid within the heads to a extent that the liquid is not discharged from the heads because Fujii et al teaches prevention of clogging as desired (see abstract).

8. Claims 5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Kawase et al in view of Suzuki (JP-2001-180007).

Kawase discloses a method of manufacturing a device, in which a film body being formed by discharging droplets onto the surface of a work from heads. Filter elements on a substrate is the work, further being EL light-emitting layers arranged, and a film body being a counter electrode film formed at a pre-determined place on the EL light-emitting layers (see fig. 8; col 2, lines 38-67).

Kawase does not disclose what is described as the film forming method of claim 1.

Suzuki discloses what is described in the 35 USC 102 rejection above as the film forming method of claim 1.

It would have been obvious to one with ordinary skill in the art to include the film forming method of claim 1 because Suzuki teaches advantages of reduction in throughput loss (see abstract).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase et al in view of Suzuki (JP-2001-180007) as applied to claim 5 above, and further in view of Sekiguchi.

Kawase et al and Suzuki (JP-2001-180007) do not disclose the work being a lens, and the film body being a transmissive coating for coating the lens.

Sekiguchi discloses the work being a lens, and the film body being a transmissive coating for coating the lens (col 20, lines 6-13).

It would have been obvious to one with ordinary skill in the art to include such because Sekiguchi teaches advantages of using a lens (col 20, lines 6-13).

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 4-8 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of copending Application No. 11/588,240. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alain L. Bashore
Primary Examiner
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